

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the amendments above and the following remarks. Claims 1-11 are pending in the present application, of which Claim 1 is independent. Claims 2-11 have been amended to correct typographical errors. Claims 12-16 have been cancelled without prejudice or disclaimer of the subject matter contained therein.

No new matter has been introduced by way of the amendments and entry thereof is respectfully requested.

Restriction

The Official Action has withdrawn Claims 12-16 from further consideration as being drawn to a non-elected invention. By virtue of the amendments above, Claims 12-16 have been canceled without prejudice or disclaimer of the subject matter contained therein.

Information Disclosure Statement

The acknowledgement of the documents cited in the Information Disclosure Statement filed on October 26, 2001 is noted with appreciation.

Drawings

The drawings have been objected to under 37 C.F.R. 1.83(a). The Official Action indicates that the drawings must show every feature specified in the claims. Although Applicants believe that all of the features contained in the claims are shown in the drawings, the Applicants have submitted amended Figure 1 to further expedite prosecution of the present application. More particularly, Figure 1 has been amended to explicitly depict the

following features: communication device that is verification-data protected; communication device that supports a first password; public communications network; a dedicated communication device; mobile phone; and two-way pager. In addition, a formal version of Figure 2 is also submitted herewith. No new matter has been added by way of the amendment to Figure 1 and the submission of Figure 2.

Applicants therefore respectfully request entry of the attached REPLACEMENT SHEETS for Figures 1 and 2, and withdrawal of the objection to the drawings.

Claim Rejection under 35 U.S.C. §112, second paragraph

The Official Action sets forth a rejection of Claims 2-11 as allegedly being indefinite under 35 U.S.C. §112, second paragraph. Claims 2-11 have been amended in minor respects to be in better compliance with the provisions of 35 U.S.C. §112, second paragraph. No new matter has been introduced by way of these claim amendments. The Examiner is therefore respectfully requested to withdraw the rejection of Claims 2-11.

Claim Rejection under 35 U.S.C. 102

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

U.S. Patent No. 5,852,773 to Hu

The Official Action sets forth a rejection of Claims 1-11 under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 5,852,773 to Hu. This rejection is respectfully traversed because Hu does not disclose each and every element contained in independent Claim 1 and the claims that depend therefrom.

Claim 1 recites a method in a transaction system for authorizing a commercial transaction, comprising "receiving transaction-related information, including an account identifier of an account," "accessing and verifying information associated with the account," "generating an approval signal upon satisfactory verification" and "contacting a communication device associated with the account." Claim 1 further comprises "requesting a transaction confirmation from the communication device" and "authorizing the commercial transaction on receiving the approval signal and the transaction confirmation."

Hu discloses a business transaction network including a wireless communication link (Abstract). According to Hu, a public switched telephone network (PSTN) is used to connect a transaction terminal to a computer processing center. (Column 1, lines 12-18).

Hu, however, fails to disclose each and every element claimed in Claim 1 of the present invention. For instance, Hu fails to disclose a method in a transaction system *for*

authorizing a commercial transaction, comprising "receiving transaction-related information, including an account identifier of an account," "*accessing and verifying information associated with the account*," "*generating an approval signal* upon satisfactory verification," "contacting a communication device associated with the account," "*requesting a transaction confirmation* from the communication device" and "*authorizing the commercial transaction* on receiving the approval signal and the transaction confirmation". More specifically, the PSTN disclosed in Hu fails to provide access and verification of transaction-related information. In addition, Hu fails to disclose "*generating an approval signal* upon satisfactory verification." Instead, the PSTN disclosed by Hu is used for connection to multiple card transaction terminals. (Column 4, lines 55-60).

The Official Action alleges that Hu discloses "contacting a communication device associated with the account" and refers to "a modem on the network" (Official Action, page 4). This allegation appears to be unsupported by the disclosure of Hu. More specifically, the modem disclosed in Hu is used by a Wireless Concentrator Controller (WCC) for gaining access to telephone lines (Column 4, lines 1-10). In this regard, for instance, Hu does not disclose that a transaction confirmation is requested from the modem. Thus, Hu fails to teach that a modem is "a communications device", wherein "a transaction confirmation" is requested "from the communication device," as recited in Claim 1.

In addition, the Official Action alleges that Hu discloses "authorizing the commercial transaction." This allegation is also lacking because the Official Action only makes a general statement that the "authorizing" feature is inherent. More particularly, the Official Action fails to provide any evidence or point to any specific disclosure in Hu of "authorizing the commercial transaction *on receiving the approval signal and the transaction confirmation*," as recited in Claim 1. In addition, the Official Action fails to point to any specific disclosure

in Hu that anticipates the other recited features of Claim 1. More particularly, the Official Action fails to clearly articulate how Hu discloses each and every element of the pending claims. Thus, it is unclear how many of the claimed features are interpreted.

In any regard, Hu clearly fails to disclose each and every element claimed in Claim 1 of the present invention for at least the reasons set forth above. As such, Hu cannot anticipate Claim 1. Accordingly, the Examiner is respectfully requested to withdraw the rejection of Claim 1 and to allow this claim. Claims 2-11 depend upon allowable Claim 1 and are also allowable over Hu at least by virtue of their dependencies.

The Official Action fails to assert how the disclosure contained in Hu is being interpreted to reject Claims 2-11. For instance, the Official Action does not point to any particular section in Hu that allegedly discloses any of the features claimed in Claims 2-11. In this regard, it is difficult for the Applicants to meaningfully respond to the rejection of Claims 2-11 as the interpretation contained in the Official Action is unclear. However, because Claim 1 has been shown to be allowable over Hu, it is respectfully submitted that Claims 2-11 are also allowable over Hu, irrespective of the interpretation contained in the Official Action.

U.S. Patent No. 6,535,726 to Johnson

The Official Action sets forth a rejection of Claims 1-11 under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 6,535,726 to Johnson (“Johnson”). This rejection is respectfully traversed because Johnson does not disclose each and every element contained in independent Claim 1 and the claims that depend therefrom.

Initially, it is respectfully submitted that Johnson does not qualify as a prior art reference under 35 U.S.C. §102(b), which states “the invention was patented or described in a

printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States". The present application has a filing date of October 26, 2001 and Johnson has an issue date of March 18, 2003. Clearly, therefore, Johnson does not have an issue date that is more than one year prior to the filing date of the present application. The Examiner is therefore respectfully requested to withdraw the rejection of Claim 1 as being anticipated by Johnson under 35 U.S.C. §102(b).

Although the rejection of Claims 1-11 as set forth in the Official Action is clearly improper for at least the foregoing reasons, Applicants submit the following remarks to expedite prosecution of the present application.

Johnson discloses telephone-based transaction processing (Abstract). According to Johnson, a transaction using a fuel dispenser may be associated with an interface between the fuel dispenser and a customer's telephone (Column 2, lines 55-60).

Johnson fails to teach a method in a transaction system for authorizing a commercial transaction, comprising "receiving transaction-related information, including an account identifier of an account," "accessing and verifying information associated with the account," "generating an approval signal upon satisfactory verification," "contacting a communication device associated with the account," "requesting a transaction confirmation from the communication device" and "authorizing the commercial transaction on receiving the approval signal and the transaction confirmation," as recited in claim 1. More specifically, the telephone-based transaction processing disclosed by Johnson fails to provide "generating *an approval signal* upon satisfactory verification," "contacting a communication device associated with the account," "requesting *a transaction confirmation* from the communication

device" and "authorizing the commercial transaction *on receiving the approval signal and the transaction confirmation*," and the other features as recited in Claim 1.

Furthermore, the Official Action fails to point to any specific disclosure of Johnson that anticipates the recited features of Claim 1. In particular, the rejection provided in the Official Action fails to clearly articulate how Johnson discloses each and every element of the pending claims. The Official Action only states that "Claims 1-11, as understood by the Examiner" are rejected under 35 U.S.C. §102(b) in view of Johnson. Since the Official Action fails to clearly articulate how Johnson discloses each and every element of the pending claims, it is unclear how many of the claimed features are interpreted.

Section 706 of the MPEP states that the goal of examination is to clearly articulate any rejection early in the prosecution process so that the Applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. This rejection is not clearly articulated. If this rejection is maintained, the Examiner must articulate how each and every feature of Claims 1-11 is disclosed by Johnson. Furthermore, if the rejection is maintained, the rejection cannot be made final because the Applicants have not had a fair opportunity to respond to a rejection that articulates how Johnson discloses each and every feature of Claims 1-11.

In any regard, Johnson clearly fails to disclose each and every element claimed in Claim 1 of the present invention for at least the reasons set forth above. As such, Johnson cannot anticipate Claim 1. Accordingly, the Examiner is respectfully requested to withdraw the rejection of Claim 1 and to allow this claim. Claims 2-11 depend upon allowable Claim 1 and are also allowable over Johnson at least by virtue of their dependencies.

Claim Rejection under 35 U.S.C. §103

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

The Official Action sets forth a rejection of Claims 1-11 under 35 U.S.C. §103(a) as allegedly being unpatentable over the disclosure contained in Johnson. This rejection is respectfully traversed because Johnson fails to teach or suggest the invention as set forth in independent Claim 1, upon which Claims 2-11 depend. The deficiencies of Johnson are set forth above. For at least the reasons set forth above, Johnson fails to teach or suggest the invention as set forth in Claims 1-11. Furthermore, the rejection is also traversed in view of the failure of the Official Action to clearly articulate how an allegation of an inherent disclosure by Johnson supports an obviousness rejection of Claims 1-11.

Moreover, although the Official Action alleges that it would have been obvious "to modify Johnson to include the approval steps" the Official Action has failed to clearly articulate, beyond a general and unsupported allegation, why it would have been obvious to modify Johnson. In addition, although the Official Action alleges that "such steps are old and

well known in the art," the Official Action has failed to clearly articulate exactly what specific steps the Official Action is referring to, and has failed to articulate how the Official Action is interpreting each and every feature of Claims 1-11. It is unclear how the Examiner is interpreting Johnson in a manner that discloses the features of Claims 1-11.

In addition, the Official Action has also failed to provide evidence that the steps alleged to be "old and well known in the art" are capable of instant and unquestionable demonstration as being well-known. As set forth in section 2144.03 of the MPEP:

Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of *instant and unquestionable demonstration as being well-known*. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

The Official Action has failed to provide support for the allegation that "such steps are old and well known in the art." Furthermore, the Official Action has failed to demonstrate that the facts asserted to be well-known, or to be common knowledge in the art are capable of *instant and unquestionable demonstration as being well-known*. In particular, the Official Action has failed to demonstrate that the steps recited in Claims 1-11 are capable of such instant and unquestionable demonstration as to defy dispute.

In addition, Section 2144.03 of the MPEP further states that:

If such notice is taken, the basis for such reasoning must be set forth *explicitly*. The examiner must provide *specific factual findings* predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the *explicit basis* on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action.

The Official Action has failed to clearly and explicitly articulate how the "approval steps" correspond to steps recited in Claims 1-11. The rejection fails to specifically address any of the steps recited in Claims 1-11. The method of Claims 1-11 recites several steps, none of which recite "approving." Therefore, because the Official Action has failed to set forth explicitly what "steps" are allegedly "old and well known," Applicants have not been "presented with the explicit basis on which the examiner regards the matter as subject to official notice." The Official Action must clearly provide an explicit basis on which the official notice is made, regarding the subject matter being alleged as old and well known, if the rejection is to be maintained.

In addition to the Official Notice being improper, the alleged well known subject matter as specified in the rejection fails to teach all of the features of Claim 1. In particular, the rejection alleges that the claims are anticipated "because of the inherencies noted above." The Official Action, however, fails to indicate explicitly what constitute the "inherencies" in the allegation of anticipation. In addition, Applicants note that, for at least the reasons set forth above, Johnson fails to teach or suggest the features of Claim 1.

Furthermore, the alleged well known subject matter fails to teach many of the features of dependent Claims 2-11. For example, Claim 6 recites a communication device that supports a first password. Claim 10 recites a dedicated communication device. These features are not mentioned in the rejection of Claims 1-11. If the rejection is maintained, the Official Action must provide a clear explanation of what "old and well known" subject matter teaches these features. Furthermore, the rejection cannot be made final because the Applicants must have a fair opportunity to respond to a clearly articulated rejection.

For at least these reasons, and at least by virtue of their dependencies on allowable independent Claim 1, Johnson fails to teach or suggest all the features of Claims 2-11. The

Examiner is, therefore, respectfully requested to withdraw the rejections of Claims 1-11 and to allow these claims.

Remarks Concerning Paragraphs 17 and 18 of the Official Action

Paragraph 17 states that the Examiner starts with a heavy presumption that all claim limitations are given their ordinary and accustomed meaning and that the claims are interpreted with their “broadest reasonable interpretation” (Official Action, pages 5-6). The Official Action also states the following:

However, if Applicants disagree with the Examiner and have either (a) already used lexicography or (b) wish to use lexicography and therefore (under either (a) or (b)) desire a claim limitation to have a meaning other than its ordinary and accustomed meaning, the Examiner respectfully requests Applicants in their next response to expressly indicate the claim limitation at issue and to show where in the specification or prosecution history the limitation is defined.

Firstly, the rejections provided in the Official Action fail to clearly articulate how Johnson or the alleged well known subject matter teaches each and every element of the pending claims. Thus, it is unclear how many of the claimed features are interpreted.

Secondly, neither Johnson nor the alleged well known subject matter teach each and every feature of the pending claims, as described above. Thus, the Applicants may notify the Examiner whether they disagree with the Examiner’s “broadest reasonable interpretation” when it is clear how the Examiner is interpreting the features of the pending claims and when the Examiner provides sufficient evidence that Johnson or the alleged well known subject matter teaches each and every feature of the pending claims.

Thirdly, it is not at all clear as to why the definitions for “server”, “client”, and “computer”, are cited when none of these terms are recited in any of the pending claims.

Remarks Concerning Paragraph 19 of the Official Action

Paragraph 19 of the Official Action states that Claims 1-11 do not contain product-by-process features. Claims 1-11 are directed to a method and it thus clearly does not contain product-by-process features. It is therefore not at all understood as to why a discussion of product-by-process claim treatment appears in the Official Action. The Applicants therefore respectfully request that the Official Action clearly articulate how the statements regarding product-by-process relate, if at all, to the alleged rejections of Claims 1-11. It is respectfully submitted that Applicants cannot properly respond to the statements in paragraph 19 of the Official Action unless it is clear how the Official Action is interpreting the features of the pending claims.

Remarks Concerning Paragraph 20 of the Official Action

Paragraph 20 of the Official Action refers to the recitation of "for" in Claim 1. Applicants respectfully request that the Official Action clearly articulate how the statements in paragraph 20 relate, if at all, to the rejections of Claims 1-11. Again, Applicants cannot properly respond to the statements in paragraph 20 of the Official Action unless it is clear how the Official Action is interpreting the features of the pending claims.

Remarks Concerning Paragraph 24 of the Official Action

Paragraph 24 of the Official Action refers to books by White, Derfler, and Gralla. If the disclosures contained in these books are somehow relied upon to reject any of the features of the pending claims, the Examiner must set forth how these books are being relied upon and provide an explanation of how these books disclose the features of the pending claims. If the Examiner relies on any disclosures from these books, the Examiner must also provide copies

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of the relevant sections of the books to the Applicants. It is unclear, however, as to how these books relate to the present application and whether they do, in fact, pertain to the present application in any respect. The Examiner is therefore respectfully requested to provide Applicants with an explanation of the relevance between the cited books and the present application or to provide an indication that the cited books have no relevance to the present application.

Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below.

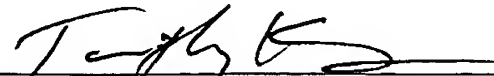
Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

Kee Hooi Jimmy NG et al.

Dated: April 26, 2005

By



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